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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,136

Applicant(s)

VAIDYANATHAN ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This is in response to the applicant's communication filed on December 6, 2004, wherein:

Claims 49-65 are currently pending;

Claim 57 is amended;

Claims 64-65 have been added.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on December 10, 2004 is being considered by the examiner.

Response to Amendment

Claim Rejections - 35 USC § 112

3. The applicant has amended claim 57. Therefore, the rejection under 35 USC Section 112 is hereby *withdrawn*.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 49-54 and 57-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Israel et al (US 6,766,307) (hereinafter referred to as Israel).

Referring to Claims 49 and 58:

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Israel discloses a method and system for performing the method comprising: providing an online dispute resolution system electronically coupled to a marketplace (web site which sells goods or services is a marketplace) that provides a website by which users buy and sell items (Fig. 1, col. 7, lines 43 thru 52, col. 8, line 48 thru col. 9, line 15);

electronically receiving with the online dispute resolution system transaction data from the marketplace that describes transactions within the marketplace (col. 6, lines 10-24, col. 9, lines 56-67 (the data relevant to the dispute input by the parties could include transaction data from the market place that describes transactions which are entered in the system and communicated electronically), col. 16, lines 36-46); and

utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace (col. 6, lines 10-24, col. 7, line 65 thru col. 8, line 10, col. 9, lines 56-67, col. 14, lines 5-8, col. 17, line 44 thru col. 18, line 4, col. 22, lines 45-67).

Referring to Claims 50 and 59:

Israel discloses a method and system for performing the method further comprising:

electronically receiving with the online dispute resolution system communications from the users of the electronic marketplace to initiate filing of disputes (col. 8, line 58 thru col. 9, line 15); and

initiating the online dispute resolution process in response to the communications (col. 4, lines 30-58, col. 8, line 58 thru col. 9, line 15).

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Referring to Claims 51 and 60:

Israel discloses a method and a system for performing the method further comprising:

electronically receiving with the online dispute resolution system enrollment requests from the sellers of the marketplace (col. 8, lines 6-10 and line 58 thru col. 9, line 15, user can be purchaser or vendor (seller)); and

automatically initiating enrollment of the sellers within the dispute resolution system in response to the request (col. 3, lines 5-34 (account number, passwords), col. 9, lines 16-29 (user directed to register with the system to obtain account number, username and password), 30-42, col. 10, lines 21-31, col. 11, line 55 thru col. 12, line 6, col. 12, lines 29-53, col. 13, lines 38-46, col. 15 – Program User Access).

Referring to Claim 52:

Israel discloses a system wherein the online dispute resolution system comprises a membership profile database that maintains status information for the sellers and buyers of the marketplace that are members of the online dispute resolution system (col. 3, lines 5-10, col. 6, lines 15-23 (real-time up dated database for managing non-judicial dispute resolution which receives, sorts and stores dispute resolution data) col. 9, lines 16-42 after user accesses the web site, if the user is a new user, they are directed to register with the system), col. 9, lines 36-42 and

wherein the online dispute resolution system electronically communicates the status information to the marketplace (col. 9, lines 31-36, col. 10, 13-20 (management module is configured to transmit notices to each party (would encompass purchaser or

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vendor) to a dispute regarding a change in the status of the dispute) and lines 32-65, Fig. 2).

Referring to Claim 53:

Israel discloses a system wherein the online dispute resolution system further comprises a server to service requests from the marketplace and to exchange data between the online dispute resolution system and the marketplace. (Figs. 1-2, col. 9, lines 43-67, (preferably the present invention resides on a state of the art, high performance computer server connected to the Internet via high speed communication lines which would make the system in Israel capable of exchanging data), col. 10 – Management Module).

Furthermore, the fact that the server is to service requests from the marketplace and to exchange data between the online dispute resolution system and the marketplace is not sufficient to overcome the prior art. The Examiner has reason to believe that the server in the system of Israel is capable of performing this function.

Apparatus (system) claims must be distinguished from the prior art in terms of structure rather than function.

Referring to Claim 54:

Israel discloses a system wherein the online dispute resolution system comprises a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace (Figs. 1-2, col. 8, line 48 thru col. 9, line 67, col. 28, line 39 thru col. 29, line 15 - Software Packages).

Furthermore, the fact that the software application automatically communicates data between a database of the online dispute resolution system and a database of the electronic marketplace is not sufficient to overcome the prior art. The Examiner has reason to believe that the software in Israel is capable of performing this function.

Referring to Claims 57 and 63:

Israel discloses a method and system for performing the method further comprising embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and file disputes (col. 8, line 48- col. 9, line 15 (hotlinks)).

Referring to Claim 61:

Israel discloses a method further comprising;
electronically communicating data that relates to the online dispute resolution process to the electronic marketplace (col. 8, line 49 thru col. 9, line 5), and
updating the electronic marketplace based on the data received from the dispute resolution system (col. 10, lines 13-20, col. 22, line 45 thru col. 23, line 35).

Referring to Claim 62:

Israel discloses a method wherein updating the electronic marketplace comprises:
displaying visual indicia ("hot link") (color coding) associated with users of the electronic marketplace that participate in the dispute resolution system within the website (col. 8, line 48 thru col. 9, line 15); and

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controlling the appearance of the visual indicia (hot link or color code) as a function of data received from the dispute resolution system (col. 8, line 48 thru col. 9, lines 15, col. 23, lines 21-35).

Regarding Claims 64 and 65:

Israel discloses a system comprising an online dispute resolution capable of receiving a query from the marketplace (col. 8, line 48 thru col. 9, line 15). The type of communication received and provided in the claim language is determined not to be a functional limitation. An apparatus (or system) must be distinguished from the prior art in terms of the structure rather than function alone. Since the Examiner has reason to believe that the functional limitations of these claims can be performed by the system of Israel, this language does not distinguish the claims from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel as applied to claim 49 above, and further in view of Sloo (Us 5,895,450).

Israel discloses the system of claim 49. Israel does not disclose:
a system wherein the online dispute resolution system electronically communicates rating data to the marketplace that relates to participation of the buyers and sellers of the marketplace within the online dispute resolution process or a system wherein the online

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dispute resolution system maintains the rating data based on compliance of the buyers and sellers to final decisions made in the resolution of the disputes.

However, Sloo discloses a system wherein the online dispute resolution system electronically communicates (col. 11, line 63 thru col. 2, lines 5) rating data to the marketplace (users or complainants may include individuals, businesses, organizations or any other entities and the complaints may relate to goods, classes of goods, services, and or the vendors, individuals, organizations, or any object) that relates to participation of the buyers and sellers of the marketplace within the online dispute resolution process or a system wherein the online dispute resolution system maintains the rating data based on compliance of the buyers and sellers to final decisions made in the resolution of the disputes (col. 2, lines 7-20, 53-65, col. 2, line 66 thru col. 3, line 7, col. 11, lines 37-43 - monitor compliance).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the disclosure of Israel the teachings of Sloo since the ratings can be used to hold the parties accountable for their conduct during the attempted resolution of the disputes to encourage good conduct and cooperation between the parties during the course of the disputes (col. 2, lines 12-20).

Furthermore, both Israel and Sloo disclose an online dispute resolution system which electronically communicates data. The type of data is considered to be non-functional descriptive data and thus does not serve as a limitation. Apparatus claims must be distinguished from the prior art in terms of structure rather than function.

Response to Arguments

6. Applicant's arguments filed on December 6, 2004 have been fully considered but they are not persuasive.

The applicant argues that Israel fails to teach or suggest an online dispute resolution system *electronically coupled to a marketplace* that provides a web-based community having buyers and sellers of goods and services. The applicant admits on page 7 of the Remarks that Israel describes a network system that enables adverse parties to conduct and manage a non-judicial dispute resolution. Thus, we have established that Israel discloses an electronic dispute resolution system.

The Examiner directs the applicant to column 8, line 48 through column 9, line 15. This excerpt discloses a "hot link" embedded within a website which interacts with the system (a system which sorts, organizes and compiles data and enables a party to avail itself of a full range of non-judicial dispute resolution procedures – col. 7, line 65 through col. 8, lines 1). Israel states that this is especially useful when the web site of another entity is engaged in a business where disputes may occur, such as, for example, a *web site which sells goods or services (on online marketplace)*. Israel's system is an avenue for conducting on-line (*electronic*) settlement of a dispute.

A marketplace as defined on www.Onelook.com is:

the world of commercial activity where goods and services are bought and sold
Thus a web site which sells goods and services would be a marketplace.

The applicant argues that Israel fails to teach or suggest an online dispute resolution that electronically receives transaction data from the marketplace that describes transactions within the electronic market place. However, Israel does disclose

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this limitation as pointed out in the rejection above and once again presented for the applicant.

electronically receiving with the online dispute resolution system transaction data from the marketplace that describes transactions within the marketplace (col. 6, lines 10-24, col. 9, lines 56-67 (the data relevant to the dispute input by the parties could include transaction data from the market place that describes transactions which are entered in the system and communicated electronically), col. 16, lines 36-46).

Even with the parties manually entering the data describing the dispute, Israel still encompasses the applicant's invention. Contrary to applicant's assertion that the system in Israel is in no manner integrated with or otherwise able to share data with an online marketplace, Israel's system can share data with an online marketplace. As stated on the bottom of page 7, Israel states that a party can access the inventive system by connecting *electronically*, such as, for example, through a web site maintained on the Internet. The fact that the party inputs data corresponding to a non-judicial dispute resolution does not preclude the system from receiving the transaction data electronically.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that electronically means without human intervention and that the transaction data is stored and sent from a marketplace database) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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The Examiner reminds the applicant of MPEP section 2111 wherein the Examiner is to give claims the broadest reasonable interpretation consistent with the supporting description without reading limitations into the claims. If applicant is having the data sent from a marketplace database where the transaction data has been stored at some earlier time, then applicant should identify this in the claim language.

As for the applicant's arguments on page 10, wherein applicant pulls out excerpts of the specification to clarify the invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For example, the applicant states that:

For purposes of clarification, Applicant refers the Examiner to paragraph [0047] and [0048] of the Applicant's application that illustrates one exemplary embodiment of Applicant's claimed invention:

The applicant then highlights the following.

These objects provide functionality to receive and send specific information to the dispute resolution system..... Example functionality includes informing the dispute resolution system of relevant partner transactions and allowing partners to query the dispute resolution system data system as the status of a specific marketplace seller.

The data manager 162 in turn communicates with one or more partner databases.

The limitations and structure in the excerpts and the accompanying excerpts (not included here) are not claimed.

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As for the applicant's arguments on page 12 stating that Israel fails to teach or suggest a system wherein the online dispute resolution system electronically communicates the status information to the marketplace, the Examiner directs the applicant to col. 9, lines 31-36, col. 10, 13-20 (management module is configured to transmit notices to each party (would encompass purchaser or vendor) to a dispute regarding a change in the status of the dispute) and lines 32-65, Fig. 2) The applicant argues limitations that are not in the claim language. The applicant on page 12 now defines the marketplace as a partner system and that the online dispute resolution system communicates with one or more databases of a partner system (the marketplace).

As for the applicant's argument regarding claim 53, Israel discloses a server (col. 9, lines 43-55). Applicant is reminded that system claims must be structurally distinguishable from the prior art in terms of structure rather than function. System claims cover what a device is, not what a device does.

As for applicant's argument regarding claim 54, the applicant argues that Israel does not teach or disclose electronically communicating data that relates to the online dispute resolution process to the electronic marketplace and updating the electronic marketplace based on the data received. The Examiner has discussed the Examiner's interpretation of marketplace above. The applicant is directed to the rejection of the claims wherein it is shown that Israel does disclose a data manager software application.

As for Claims 61 and 62, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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The applicant argues that Israel does not disclose displaying visual indicia associated with users of the electronic marketplace that participate in the dispute resolution. The applicant is directed to the following language:

This “hot link” feature (which is embedded on the web site of another entity) is especially useful when the web site of another entity is engaged in a business where disputes may occur, such as, for example, a web site which sells goods and service (col.8, line 58 thru col. 9, line 3). The hot link is a visual indicia which is embedded on a web site so as to indicate to the users that the entity associated with the hot link, said users sell goods and services, is a participant in an online dispute resolution system. The Examiner has cited col. 23, lines 21-35 which discloses the system employing a method for notifying the user of the status of the dispute by organizing the disputes entered into the system into certain color coded categories as controlling the indicia as a function of data received.

As for applicant’s argument that Sloo fails to teach communicating rating data that relates to the participation of the buyers and sellers, the Examiner once again directs the applicant to excerpts cited in the rejection. If the users are buyers and sellers, then the rating data will be communicated as to the buyer and seller’s (parties) participation. Sloo states that the central computer is programmed to monitor and rate the conduct and performance of the complainants (which can include buyers and sellers) during the course of the disputes. The ratings then can be used to affect the outcome of the disputes and to hold the parties accountable (col. 2, lines 12-20). The applicant is directed to col. 11, line 63 wherein the data record is updated to indicate compliance failure and the information is posted in the public record. Sloo in combination with Israel, which the Examiner has discussed in detail above, teach the limitations of the applicant’s claim. Once again, the

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applicant's assertion that Israel does not teach or suggest an online dispute resolution that electronically communicate to a marketplace, the Examiner sets forth the following:

1. The applicant has admitted on page 7 that Israel describes a network system that enables adverse parties to conduct and manage a non-judicial dispute resolution.
2. Israel is coupled to a marketplace as set forth on col. 8, line 58 thru col. 9, line 15.

Furthermore, Claims 55 and 56 are directed to a system. Therefore, all Israel's system or Sloo's system has to have is the ability to communicate the data to the marketplace. What the data is would be non-functional descriptive data which is not structurally related to the structure of the system. Furthermore, as stated above, an apparatus (system) must be distinguished from the prior art in terms of structure rather than function.

Sloo discloses monitoring and rating. The information used in the monitoring is used in rating the parties.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in

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entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

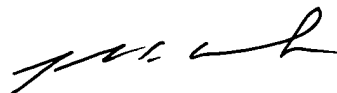
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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